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10/735,394

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Peter Euteneuer

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EXAMINER

PRITCHETT, JOSHUA L

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

09/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/735,394

Applicant(s)

EUTENEUER ET AL.

Examiner

Joshua L. Pritchett

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Request for Continued Examination and Amendment filed August 13, 2007. Claims 1 and 51 has been amended and claim 52 has been added as requested by the applicant.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 13-21, 23-26, 28-36, 38-41 and 44-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinheimer (US 4,619,503).

Regarding claim 1, Reinheimer discloses an inverted microscope having a U-shaped microscope housing (Fig. 3), on one limb (T) whereof is provided a housing attachment surface (6) for attachment of a module (5), wherein the housing attachment surface is parallel to the based of the inverted microscope (Fig. 3) and wherein the module comprises a horizontally protruding based unit (Fig. 3) having a horizontal upper surface (Fig. 3) and a binocular tube (Fig. 3; col: 5 line 40), and a photo tube (6a; examiner assumes that the reference numeral 5a in

Fig. 3 is misplaced and should be labeled 6a), with photo device placed thereon (col. 5 lines 45-49) and the binocular tube and the photo tube are mutually exclusive and extend above the housing attachment surface when the module is removably attached to the housing attachment surface (Fig. 3) and wherein from the position looking into the binocular tube an unimpeded view of the specimen is permitted (Figs 1a, 3 and 4). Reinheimer lacks specific reference to both the photo tube and binocular tube being on the same surface. It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the binocular tube to be on the same surface as the photo tube since it has been held that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in art when the change in shape is not significant to the function of the combination. Further, one would have been motivated to select the shape of the module for the purpose of allowing the user to readily switch back and forth between the view provided by the binocular tube and the phototube without having to change positions.

Regarding claim 2, Reinheimer discloses the module is embodied as a one-piece combination module (Fig. 3) and has on its underside a module attachment apparatus that is configured to be removably attached to the housing attachment surface (col. 4 lines 28-32).

Regarding claims 3, 8, 51 and 52, Reinheimer teaches the vertical optical axis of the photo beam bundle, extending in the one limb penetrates through a first optical deflection element after entering the base unit and then pass through the first tube lens arrange in the photo tube with photo device attached while the observation beam deflected at the optical deflection element after passage through a second tube lens and after deflection at a second deflection element enters the binocular tube (col. 5 lines 40-49). Reinheimer teaches the claimed invention

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except for binocular tube and photo tube being reversed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the binocular tube and the photo tube, since it have been held that a mere reversal of working parts of a device involves only routine skill in the art. One would have been motivated to reverse the binocular tube and the photo tube for the purpose of eliminating any aberrations introduced into the observed image by deflecting the observation beam, thus allowing the user to see a sharper image.

Regarding claims 4 and 9-11, Reinheimer teaches the invention as claimed but lacks optical deflection element brought into and out of working position in the Fig. 3 embodiment. Reinheimer teaches an optical deflection element (25) moving in and out of a working position (Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Reinheimer invention include in the Fig. 3 embodiment the ability to move an optical deflection element into and out of a working position for the purpose of determining providing all light to either the viewer or an image capturing device so that the image views or captured is brighter due to all the intensity going to one instead of splitting the intensity between the two.

Regarding claims 6, 7, 19-21, 23-26, 28-36, 38-41 and 43-48, Reinheimer teaches the invention as claimed but lacks reference to different corrections for the photo tube and the binocular tube. It is extremely well known in the art to use periplan correction for flat field eyepieces and HC correction for magnetic recording media. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have

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the Reinheimer invention include the corrections as known in the art for the purpose of producing a clear image to both the viewer and the photo device.

Regarding claims 13-18, Reinheimer teaches an infinity beam exists in the region of an attachment surface of the module attachment apparatus (Fig. 3).

Regarding claims 49 and 50, Reinheimer teaches the passage through a second tube is parallel to the attachment surface (Fig. 5b). Fig. 5b shows the elongated portion A would have light traveling parallel to the surface 30 similar to the Fig. 1 of the current application.

Claims 5, 12, 22, 27, 37 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinheimer (US 4,619,503) in view of Phillips (US 5,223,974).

Regarding claims 5 and 12, Reinheimer teaches the invention as claimed but lacks reference to an infinity beam. Phillips teaches the use of collimating lens (30) to create an infinity beam for an attachment module (col. 1 lines 9-13) used in a microscope (col. 1 lines 20-22; Fig. 3). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Reinheimer invention include the collimating lens of Phillips for the purpose of allowing the attachment module to adjust to the height of the user without impacting the focusing within the microscope body.

Regarding claims 22, 27, 37 and 42, Reinheimer teaches the invention as claimed but lacks reference to different corrections for the photo tube and the binocular tube. It is extremely well known in the art to use periplan correction for flat field eyepieces and HC correction for magnetic recording media. Official Notice is taken. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Reinheimer invention

include the corrections as known in the art for the purpose of producing a clear image to both the viewer and the photo device.

Response to Arguments

Applicant's arguments filed August 13, 2007 have been fully considered but they are not persuasive.

Applicant argues the Reinheimer reference is C-shaped not U-shaped. A C-shape is a U-shape turned sideways. The claim limitations do not require the object to be observed surrounded by the base and stage, therefore the Reinheimer reference satisfies the current claim limitations.

Applicant argues the module of Reinheimer does not include a binocular tube and a photo tube. Fig. 3 shows the housing (5), with a binocular tube in the upper right portion of the housing and a photo tube (6a) also part of the housing. The claim does not require the tubes themselves be detachable only that the tube be distinct from one another. The fact that two separate tubes are present teaches the photo tube and binocular tube are mutually exclusive.

Applicant argues the arrangement of the Reinheimer reference prevents a user to merely glance from the binocular tube to the sample without changing positions. Figs. 1a and 4 of Reinheimer show the lines of sight for the observer and clearly show viewing both the image of the binocular tube and the sample from a single user position.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments, see Amendment, filed August 13, 2007, with respect to the rejection(s) of claim(s) 5 and 12 under Reinheimer have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Phillips. Applicant argues the Reinheimer reference fails to teach an infinity beam. The Phillips reference has been added to clearly illustrate an infinity beam within a microscope body.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on 571-272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joshua L Pritchett
Examiner
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